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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,147	01/16/2004	Lawrence I. Wechsler	W1000-24	7189

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Lawrence I. Wechsler
One Wooleys Lane
Great Neck, NY 11023

EXAMINER

NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
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3644

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03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/760,147	Applicant(s) WECHSLER, LAWRENCE I.	
	Examiner Trinh T. Nguyen	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Election dated 12/17/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II (claims 17 and 18) in the reply filed on 12/17/07 is acknowledged. The traversal is on the ground(s) that: (1) the restriction requirement is not timely as being made after final rejection; (2) the examiner has failed to explain why examination of all of the claims presents a serious burden on the examiner; and (3) the product invention and the method invention are not distinct inventions. This is not found persuasive because regarding: (1) it is noted that the finality of the previous Office action has been withdrawn due to the request for continued examination under 37 CFR 1.114 (submitted on 9/22/06), therefore, the restriction requirement dated 9/12/07 was made before the final action (i.e. the final action being the current office action); (2) it is noted that an additional set of invention would require additional searches and consideration thus it would be a serious burden on the examiner; and (3) it is noted that in this case the product as claimed can be used to practice another and materially different method such as a method that does not require the animal to grip specifically on the animal access region and that the animal can grip on the toy at any desirable places on the toy since the animal's action is unpredictable and uncertain.
2. Claims 1-16 and 19-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.
3. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the limitation "providing the toy with an animal restricted region which is less likely to be accessed by the mouth of the animal" is unclear since it is not understood on how "an animal restricted region which is less likely to be accessed by the mouth of the animal" is performed since the animal's action is unpredictable and uncertain. Furthermore, it is not understood on how "gripping of the animal access region in the mouth of the animal" is performed since the animal's action is unpredictable and uncertain and that the animal can/might bite the toy at any areas other than the animal access region.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claim 17, it is unclear on how the limitations of “an animal restricted region which is less likely to be accessed by the mouth of the animal” and “gripping of the animal access region in the mouth of the animal” are performed since the animal’s action is unpredictable and uncertain and that the animal can/might bite the toy at any areas other than the animal access region.

9. In claim 18, it is unclear on how the limitation of “the animal gripped the animal access region in the mouth” is performed since the animal’s action is unpredictable and uncertain and that the animal can/might bite the toy at any areas other than the animal access region.

Claim Rejections - 35 USC § 103

10. Claims 17 and 18 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over O’Rourke (US5092272).

For claim 17, O’Rourke teaches a method of inhibiting user hand contact with animal saliva deposited on a play toy during interactive play by the animal and the user, comprising the steps of:

providing the toy with an animal access region (16,18,24,26) readily available to gripping in a mouth of the animal;

providing the toy with an animal restricted region (42) which is less likely to be accessed by the mouth of the animal, said animal restricted region being hand-holdable by the user; and

presenting the toy to the animal during the interactive play.

O'Rourke lacks to mention the step of handling the toy following gripping of the animal access region in the mouth of the animal by holding said animal restricted region in the hand of the user. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the teaching of O'Rourke so as to handle the toy following gripping of the animal access region in the mouth of the animal by holding said animal restricted region in the hand of the user since it is well known in the art of animal husbandry (especially in animal toy) that such action will be depended on the user's choice of preference on whether to provide an interactive play with the animal or not.

For claim 18, O'Rourke as modified further teaches the steps of making the toy available to the animal so that at least a portion of the animal access region is gripped in the mouth of the animal (note that first the user can hold to the animal restricted region (42) and then offer the animal access region (16,18,24,26) to the animal so that the animal can grip the animal access region in the mouth) and grabbing the animal restricted region with the hand of the user at least after the animal gripped the animal access region in the mouth (note that this step "grabbing..." is similar to the step "handling..." as claimed in claim 17 above, therefore, see above in the rejection of claim 17 for further explanation).

Response to Arguments

11. Applicant's arguments with respect to claims 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571) 272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Trinh T Nguyen/
Primary Examiner, Art Unit 3644
3/9/08